THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIMFIELD PRECISION INC.

Appeal No. 98-1313
Control No. 90/003,670[1]

ON BRIEF

Before FRANKFORT, PATE and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Brimfield Precision Inc. originally took this appeal from the final rejection of claims 1 through 9, all of the claims

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[1] Request filed December 23, 1994 for the reexamination of U.S. Patent No. 5,263,967, issued November 23, 1993, based on Application 07/883,080, filed May 15, 1992.

pending in this reexamination proceeding involving U.S. Patent No. 5,263,967.[2] Upon reconsideration, the examiner has since withdrawn all rejections of claims 1 through 8 (see page 1 in the answer, Paper No. 25). Therefore, the appeal as to claims 1 through 8 is hereby dismissed, leaving for review the standing rejection of claim 9.[3]

The invention relates to a medical instrument which is defined in claim 9 as follows:

9. A medical instrument comprising:

a tubular extension having a longitudinal axis, a distal end and a proximal end;

at least one movable end effector pivotally attached by a pivot to said distal end of said tubular extension; and

a drive member located within the tubular extension and capable of moving between a first proximal position and a second distal position within said tubular extension,

said drive member having at least one arm pivotally attached by a pin and hole attachment to said movable end effector, said arm having a distalmost end surface for transferring force to said movable end effector,

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[2] The record in U.S. Patent No. 5,263,967 indicates that it was involved in an interference (Interference No. 103,917) in which final judgement adverse to the patentee was rendered with respect to patent claims 1 through 5.

[3] Claim 9 has been amended subsequent to final rejection.

wherein when said drive member is moved in said distal direction, force is transferred to said movable end effector causing said movable end effector to rotate about said pivot toward said longitudinal axis.

The reference relied upon by the examiner as evidence of anticipation is:

Honkanen et al. (Honkanen) 5,152,780 Oct. 6, 1992 (filed May 31, 1990)

Claim 9 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Honkanen.[4]

Reference is made to the appellant's brief (Paper No. 19) and to the examiner's answer (Paper No. 25) for the respective positions of the appellant and the examiner with regard to the merits of this rejection.

Honkanen discloses an endoscopic punch for use in temporal-mandibular joint surgery. As described in the reference,

> [t]he punch has an elongated probe 8 (FIG. 2) with an outer tip 12 of U-shape form with an end 14 and sidewalls 16 and 18 with upper and lower cutting

[4] In the final rejection (Paper No. 15), claim 9 also was rejected under 35 U.S.C. § 112, second paragraph. The examiner withdrew this rejection in view of the amendments made to claim 9 subsequent to final rejection (see the advisory action mailed October 15, 1996, Paper No. 17).

> edges 16E and 18E (FIG. 1) and an integral pivot 20 . . . integrally formed with and bridging the walls 16 and 18. An inner tip 22 is mounted on the pivot for rotation as indicated by the double arrow shown in FIG. 1 between an open position (FIG. 1) and a closed position nested within the outer tip. . . .
>
> The upper portion of the inner tip . . . has a cross-hole 29. This cross hole accommodates a pivot 30 that is an integral pivot extension of a linearly moveable actuating link 26, moveable as indicated by arrow M, riding in a channel 28 and coupled to the inner tip by said pivot 30 that passes through hole 29 in the tip, to drive the inner tip between end positions.
>
> The inner tip has a cut out recess 32 to accommodate the rounded end of link 26. As shown in FIGS. 2B, 2A, 1A and 1 the linear movement of link 26 is transmitted via pivot 30 to the inner tip to move the inner tip through an arc of up to 90 degrees. The inner tip recess includes a front wall 34 that absorbs part of the actuating force applied through link 26 as inner tip 22 is moved counter clockwise against resistant tissue.
>
> . . . A bushing 50 carries probe 8. The bushing is, in turn, encased in a handle assembly 52 (FIG. 3) comprising a thumb loop 54 and a finger loop 56 pivoted at fulcrum 60. The top of the finger loop above the fulcrum has an axial slot 56-1 (FIG. 3A) and cross slots 56-2, 56-3 forming a fork to receive a cross pin 27 (FIG. 2) through the actuating linkage, thus allowing movement of the finger loop to impart driving force M to the actuator linkage [column 3, lines 11 through 56].

Anticipation is established only when a single prior art reference discloses, expressly or under principles of

inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

The appellant contends that the subject matter recited in claim 9 is not anticipated by Honkanen because this reference does not meet the claim limitation requiring a movable end effector pivotally attached by a pivot to the distal end of a tubular extension (see pages 11 and 12 in the brief).

The examiner, on the other hand, submits that Honkanen's rotatable inner tip 22 constitutes a movable end effector which is pivotally attached by a pivot 20 to the distal end of a tubular extension composed of either (1) the probe 8 and the tubular sleeve shown in Figures 1, 1A and 2 as surrounding it or (2) the tubular sleeve itself (see page 4 in the answer).

The examiner's determination that Honkanen's rotatable inner tip 22 constitutes an end effector is well taken. The related finding that this end effector is pivotally attached by a pivot to the distal end of a tubular extension is not. As indicated above, inner tip 12 is pivotally attached by pivot 20 to the outer tip or distal end 12 of probe 8. As seems to have been implicitly conceded by the examiner, the

probe 8 is not, in and of itself, a “tubular” extension. The examiner’s characterization of the combination of the probe 8 and the surrounding tubular sleeve as a “tubular” extension rests on an unreasonable interpretation of both the claim language at issue and the Honkanen disclosure. Moreover, although Honkanen’s tubular sleeve might itself be a “tubular” extension, the inner
tip or end effector 12 is pivotally attached to the probe 8 and not to the sleeve. Thus, the appellant’s position that Honkanen does not meet the limitation in claim 9 requiring a movable end effector pivotally attached by a pivot to the distal end of a tubular extension is well founded.

Since Honkanen does not disclose each and every element of the invention recited in claim 9, we shall not sustain the standing 35 U.S.C. § 102(e) rejection of this claim.

The decision of the examiner is reversed.

REVERSED

CHARLES E. FRANKFORT)

Administrative Patent Judge	)	
	)	
	)	
	)	
WILLIAM F. PATE, III	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
JOHN P. McQUADE	)	
Administrative Patent Judge	)	

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JPM/ki